

Serial No. 09/782,539**Response to Off. Act. of Sept. 2, 2005****UTILITY PATENT****B&D No. TN-1379A**

In re Smythe, 480 F.2d 1376, 178 USPQ 279 (CCPA 1973)). To establish inherency, it must be shown that the originally-missing/late-added descriptive matter is "necessarily present" in the disclosure, and that "it would be so recognized by persons of ordinary skill in the art." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (*cited by* MPEP § 2163.07(a)).

In the present case, Applicants submit that a person of ordinary skill in the art would recognize that (a) a memory 53M for storing data is necessarily present in computer 53, and (b) that the information downloaded from memory 52 into computer 53 would necessarily be stored in memory 53M. Because such memory would necessarily be found in a computer, the third memory 53M is inherent, and thus can be added to the disclosure without constituting new matter. If the Examiner disagrees, Applicants request that the Examiner present evidence of any computer (such as the one shown in FIG. 4 of the present application) that does not have a memory for storing information.

Further evidence that the third memory was originally present in the disclosure via inherency is the Examiner's own reliance on an inherent memory in a computer disclosed in US Patent No. 5,349,535 ("Gupta"). If the Examiner is willing to find that a memory is inherent in a prior art computer, the Examiner should also find that a memory is inherent in the presently-disclosed computer. If the Examiner disagrees, then the Examiner needs to show why the memory is inherent in the prior art computer, but not in the presently-disclosed computer. Otherwise, the Examiner should withdraw the rejection based on inherency.

Serial No. 09/782,539**Response to Off. Act. of Sept. 2, 2005****UTILITY PATENT****B&D No. TN-1379A**

The Examiner rejected Claims 25-26 and 30-32 under 35 USC § 103(a) as being unpatentable over US Patent No. 5,903,462 ("Wagner") in view of US Patent No. 5,349,535 ("Gupta"). This rejection is respectfully traversed.

Claim 25 calls for a power tool system comprising a power tool including a first memory for storing use profile information about the power tool, a reader apparatus connectable to the power tool for downloading the stored use profile information from the first memory, the reader apparatus comprising a second memory for storing the stored use profile information downloaded from the first memory, and a computer separate from the reader apparatus and connectable to the reader apparatus for downloading the downloaded information from the second memory of the reader apparatus, the computer comprising a third memory for storing the downloaded information from the second memory.

Admittedly, Wagner discloses a power tool with a memory for storing use profile information, and a computer with a memory for downloading such information. However, Wagner does not disclose a reader apparatus separate from the computer for downloading the information from the power tool and later sending it to the computer. Indeed, the Board of Appeals noted in its decision in the present case that "Wagner does not specifically address such a configuration."

By contradistinction, Claim 25 requires "a reader apparatus connectable to the power tool for downloading the stored use profile information from the first memory, the reader apparatus comprising a second memory for storing the stored use profile information downloaded from the first memory, and a computer separate from the reader apparatus and connectable to the reader

Serial No. 09/782,539**Response to Off. Act. of Sept. 2, 2005****UTILITY PATENT****B&D No. TN-1379A**

apparatus for downloading the downloaded information from the second memory of the reader apparatus." Such arrangement is critical as it allows a person to obtain the store information at the construction jobsite without bringing fragile computers to hook up to the power tool.

The Examiner has argued that such missing elements may be found in Gupta. In particular, the Examiner alleges that "Gupta discloses a system for acquiring and storing information about a device." Such information is then dumped into a computer. Based on such interpretation of Gupta, it would be obvious to "include a second, in situ memory, as disclosed by Gupta, in order to hold the data when the CPU power supply is removed."

The combination of Wagner and Gupta, however, is improper for several reasons. First, Gupta is not analogous prior art. Second, no motivation exists to combine Wagner and Gupta as such combination would change Wagner's principle of operation. Third, even if Wagner and Gupta were to be combined, the resulting combination would lack some of the claimed elements.

As mentioned above, Gupta is not analogous prior art as a person skilled in the power tool field would not look to the vehicle battery monitoring field for a solution. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992) (quoted by MPEP § 2141.01(a), at 2100-122 (8th ed., Rev. 2, May 2004)).

MPEP § 2141.01(a) and the Federal Circuit have provided an example of non-analogy in the electrical arts. In *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed.

Serial No. 09/782,539

Response to Off. Act. of Sept. 2, 2005

UTILITY PATENT

B&D No. TN-1379A

Cir. 1993), the Federal Circuit found that a reference disclosing single in-line memory modules (SIMMs) in an industrial controller was not in the same field of endeavor as the claimed SIMMs used in personal computers, even though they both related to memories. The court found that the reference was not analogous partly due to the fact that the reference SIMMs were used differently than in the claimed subject matter.

Similarly, Gupta pertains "to the field of devices for monitoring the condition of a battery... especially applicable to the field of battery packs for electric vehicles." Gupta, col. 1, lines 6-12. In particular, Gupta discloses a monitoring device that is directly connected to a battery to be monitored. Gupta, col. 5, lines 54-55. The device receives information from sensors in the battery through input ports 13. Gupta, col. 7, lines 37-47. Such information is then stored and later sent to an external computer. Gupta, col. 5, lines 30-31.

Accordingly, the purpose of the Gupta device is to sense different conditions in an electric vehicle battery pack, store such information and then send the information to an external computer. It is important to note that Gupta does not disclose or suggest that the device read a memory in the battery pack.

As in *Wang*, the Gupta device is used for a different purpose than the claimed subject matter, which is to download information stored in a power tool into a computer through a reader apparatus. Accordingly, the field of electric vehicles battery pack monitoring is not the same as the power tool field, and more specifically to the power tool information download field. Therefore, Gupta is not analogous prior art to the present claimed subject matter.

Serial No. 09/782,539**Response to Off. Act. of Sept. 2, 2005****UTILITY PATENT****B&D No. TN-1379A**

Second, if Wagner were to be modified as per Gupta's teachings, Wagner would not have a computer read the information stored in the power tool memory. Instead, it would have a monitoring device constantly obtaining information about the power tool without accessing the power tool memory, and providing that obtained information to the computer. Such modification however would change Wagner's principle of operation.

According to the CCPA, if the proposed modification of the prior art changes the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In Wagner, the stored information is directly obtained and analyzed by the computer connected to the power tool. Gupta teaches instead to bypass the power tool memory and read the power tool conditions. Such arrangement changes Wagner's principle of obtaining information from the power tool memory and providing it to the computer. Accordingly, no suggestion exists to modify Wagner as proposed by the Examiner.

Finally, even if Wagner and Gupta were to be combined, the resulting combination would not result in the claimed subject matter. As discussed above, the resulting combination would have a power tool with a memory, a sensor apparatus with a memory, the sensor apparatus being connected to the power tool sensors (and not to the power tool memory), and a computer for reading the memory of the sensor apparatus.

Serial No. 09/782,539

Response to Off. Act. of Sept. 2, 2005

UTILITY PATENT

B&D No. TN-1379A

By contradistinction, Claim 25 requires "a reader apparatus connectable to the power tool for downloading the stored use profile information from the first memory, the reader apparatus comprising a second memory for storing the stored use profile information downloaded from the first memory." Because the Gupta portion would bypass and not interact with the power tool memory, the resulting combination would not have a reader apparatus for downloading the stored information from the power tool memory.

Therefore, Wagner and Gupta cannot render Claims 25-26 and 30-32 unpatentable.

All the claims are patentable and the application is believed to be in condition for formal allowance. Reconsideration of the application and allowance of Claims 25-26 and 30-32 are respectfully requested.

No fee is due for the present amendment. Nevertheless, the Commissioner is authorized to charge payment of any fees due in processing this response, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,



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